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| EXAMINER DEBNATH, SUMAN | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,355

Applicant(s)

SHAPIRO ET AL

Examiner

SUMAN DEBNATH

Art Unit

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-16 are pending in this application.
2. Claims 17-56 were previously cancelled.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

4. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Patent No.: US 5,884,270) (hereinafter "Walker") and further in view of Bisbee et al. (Patent No.: US 5,748,738) (hereinafter "Bisbee").
5. As to claim 1, Walker discloses a method of providing access to a candidate's personal background data, wherein the data have been verified (abstract), the method comprising:
 - a. establishing a data record, relating to the candidate's personal background data, in a digital storage medium (col. 8, lines 24-30, "stores the received party data ...in database"), the data record associated with a unique identifier and including
 - (i) a set of components based on information supplied by the candidate, each component being potentially verifiable ("...verification may includes verifying he authenticity of any one of the origin, authorship and integrity of the party data stored in databases" -e.g. see, col. 18, lines 5-10, see also col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39), and
 - (ii) a corresponding set of query results, the corresponding set including, with respect to each component, the result of a verification query to a third party ((col. 8, lines 15-19 and col. 17,

lines 63-67 to col. 18, lines 1-32 “..verification may includes verifying he authenticity of any one of the origin, authorship and integrity of the party data stored in databases” -e.g. see, col. 18, lines 5-10);

b. communicating the identifier to the candidate (“unique transaction ID” –e.g. see, col. 17, lines 10-25);

Walker doesn't explicitly disclose but Bisbee discloses:

c. receiving, over a communication network, the identifier from an outside user wanting verification of the candidate's personal background data, the outside user having received the identifier directly or indirectly from the candidate (abstract, “appending a certificate to the electronic document” –e.g. see col. 3, lines 3-11, see also, col. 3, lines 30-37, col. 5, lines 28-38); and

d. distributing, to the outside user, over the communication network, in response to receiving the identifier, an electronic document including the data record and an electronic authentication of the contents of the data record, the electronic authentication capable of revealing unauthorized modifications of the contents of the data record (abstract, “appending a certificate to the electronic document” –e.g. see col. 3, lines 3-11, see also, col. 3, lines 30-37, col. 5, lines 28-38).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching Walker as taught by Bisbee in order to integrity of the document that are transmitted over public network.

6. As to claim 2, the combination of Walker and Bisbee discloses wherein establishing the data record includes:

a. from a computer at a first location, separately specifying over a network to a host computer a set of components of the candidate's personal background data, each component being potentially verifiable by contacting a third party (Walker: col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39);

b. storing, in a digital storage medium in communication with the host computer, the set of components (Walker: col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39);

c. for each component of the set, identifying a relevant third party and pertinent contact information therefor (Walker: col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39);

communicating a query to the relevant third party to verify the component, and obtaining a query result from the query (Walker: col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39); and

associating the query result with the component and storing the query result in the storage medium (Walker: col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39).

7. As to claim 3, the combination of Walker and Bisbee discloses wherein specifying the set of components includes providing responses via a set of templates, the set of templates having at least one member and being structured to evince the content of the set of components (Walker: col. 15, lines 27-39).

8. As to claim 4, the combination of Walker and Bisbee discloses wherein specifying the set of components is performed over the Internet (Walker: FIG. 1).

9. As to claim 5, the combination of Walker and Bisbee discloses in which obtaining a query result from the query is performed over the Internet (Walker: col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39).

10. As to claim 6, the combination of Walker and Bisbee discloses wherein specifying the set of components includes specifying the set of components to a World Wide Web server (Walker: col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39).

11. As to claim 7, the combination of Walker and Bisbee discloses in which communicating a query to the relevant third party to verify the component is performed over the Internet (Walker: col. 6, lines 60-67 to col. 7, lines 1-22 and col. 15, lines 27-39).

12. As to claim 8, the combination of Walker and Bisbee discloses wherein communicating a query to the relevant third party to verify the component is performed automatically and includes sending the query as E-Mail (Walker: col. 8, lines 38-50).

13. As to claim 9, the combination of Walker and Bisbee discloses the combination of Walker and Bisbee discloses in which communicating the identifier to the candidate is performed over the Internet (Walker: col. 17, lines 10-30).

14. As to claim 10, the combination of Walker and Bisbee discloses the combination of Walker and Bisbee discloses wherein communicating the identifier to the candidate is performed automatically and includes sending the identifier as E-Mail over the Internet (Walker: col. 8, lines 38-50, col. 17, lines 10-30).

15. As to claim 11, the combination of Walker and Bisbee discloses wherein the electronic document is distributed in the form of an electronic mail message (Bisbee: col. 3, lines 3-11, see also, col. 3, lines 30-37, col. 5, lines 28-38).

16. As to claim 12, the combination of Walker and Bisbee discloses wherein the electronic document is distributed in the form of an electronic file (Walker: col. 8, lines 38-50, col. 17, lines 10-30).

17. As to claim 13, the combination of Walker and Bisbee discloses wherein the electronic authentication is an electronic watermark (Bisbee: col. 3, lines 3-11, see also, col. 3, lines 30-37, col. 5, lines 28-38).

18. As to claim 14, the combination of Walker and Bisbee discloses wherein the electronic authentication is an electronic certification (Bisbee: col. 3, lines 3-11, see also, col. 3, lines 30-37, col. 5, lines 28-38).

19. As to claim 15, the combination of Walker and Bisbee discloses wherein the set of components includes the candidate's resume information, and wherein the set of query results includes information verifying the candidate's resume information (Walker: col. 8, lines 38-50, col. 17, lines 10-30).

20. As to claim 16, it is rejected using the same rationale as for the rejection of claim 1.

21. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

22. Applicant's arguments filed February 17, 2009 have been fully considered but they are not persuasive.

Applicant argues that: "Walker does not provide a method for the candidate to provide verified personal background data to an outside user, does not establish a data record relating to the candidate's personal background data that is associated with a unique identifier and includes

a set of potentially verifiable components and a corresponding set of query results, does not communicate a unique identifier to the candidate identifying such a data record, and does not permit access to such a data record by a person providing such a unique identifier, as in the presently claimed invention”.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, Walker teaches a unique identifier to provide verified personal background data (e.g. see, col. 17, lines 8-45, “unique transaction ID”, It should be noted that unique transaction ID is a unique identifier for providing resume (i.e. personal background) to an employer; a permission certificate is generated to release the data to a party, e.g. see, col. 17, lines 30-45). It should be that nowhere in the claim, Applicant claimed that unique identifier couldn't be different for different employers. Examiner asserts that Walker is sufficient enough to providing the personal background data to an outside user, however, Walker is not explicit enough, therefore, secondary reference Bisbee is cited wherein Bisbee provides electronic document to a third party (Bisbee teaches this concept by appending a certificate to provide electronic document to third party, e.g. see col. 3, lines 3-11 and lines 30-37; wherein the certificate includes information representing the transfer agent's identity, e.g. see, col. 3, lines 8-10).

Applicant argues that: "Walker does not enable **the job candidate** to present an employer directly with a **key** (such an applicant's "unique identifier") that gives **direct access** to personal background data that have been verified".

It should be noted that Examiner's job is to examine the claims as they stand without reading into the claims. Walker clearly teaching the concept of providing a unique transaction ID which is encrypted party's public key and provided to the party who would release the data and generates a permission certificate comprising a unique transaction ID (e.g. see col. 17, lines 10-45).

Applicant argues that: "It is important to note that at no point des Walker provide the job candidate with a unique identifier that gives access to the candidate's verified personal background data."

Examiner maintains that Walker clearly teaches this concept wherein a unique transaction ID is provided to a party encrypted with party's public key; wherein in reply to the unique transaction ID, a unique permission certificate is generated if the party desires to release the verified personal data (e.g. see, col. 17, lines 10-45). It should be noted that the receiving end will receive verified data because it includes permission certificate which was generated by the releasing party. Permission certificate would determine if the originated party.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "The permission certificate is not re-used: the candidate is asked to issue a different permission

certificate every time that the candidate's resume is released to a different employer") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It should be noted that with a broader interpretation, it's not necessary to interpret that the identifier was re-used since nowhere in the claim was mentioned that identifier was re-used every time the candidate's resume is released to a different employer. Claims are examined as they stand without reading into the claims.

Applicant argues that: "Bisbee does not disclose receipt of an identifier that had been communicated to the candidate who supplied the set of components for the data record".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, Walker clearly teaches this concept wherein a unique transaction ID is provided to a party (i.e. to a candidate) encrypted with party's public key; wherein in reply to the unique transaction ID, a unique permission certificate is generated if the party desires to release the verified personal data (e.g. see, col. 17, lines 10-45). It should be noted that the receiving end will receive verified data because it includes permission certificate which was generated by the releasing party. Permission certificate would determine if the originated party.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUMAN DEBNATH whose telephone number is (571)270-1256. The examiner can normally be reached on 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D./
Examiner, Art Unit 2435

/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435